UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/971,993	10/05/2001	Danny W. Bilycu	4944US (01-03-105)	4144

7590 02/01/2007

MARSHALL GERSTEIN & BORUN
6300 SEARS TOWER
233 SOUTH WACKER DRIVE
CHICAGO, IL 60606-6402

EXAMINER	
HARPER, TRAMAR YONG	
ART UNIT	PAPER NUMBER
3714	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/01/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/971,993	BILYEU ET AL.	
	Examiner	Art Unit	
	Tramar Harper	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 December 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *29-54* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *29-54* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Examiner acknowledges receipt of arguments/remarks received on 12/11/06. The arguments set for the in the response are addressed herein below. Claims 29-54 remain pending, no Claims have been amended, and Claims 1-28 have been canceled.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 29-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hughs-Baird et al (US 6,981,635) in view of Bennett (US 6,251,013).

Claims 29, 31-35, 41-43, & 46-49: Hughs-Baird discloses a gaming slot machine where a player initiates spinning video reels, by placing a wager. If the reels display at least two symbols on the same horizontal row, the game displays interaction between the symbols and a payout is awarded to the player. As such, the game allows the player to select one or more of the interacting symbols via a touch screen (Col. 1:63-Col. 2:8; Col. 5:55-65). Referring to Figs. 5a-d, a player selects interacting symbol (80), and as a result the two symbols to the left of (80) transforms and an award is displayed in Fig. 5d (Col. 7:55-65). Also, the gaming device comprises of a display device, a wager acceptor device, a user input device (touch screen), and a processor and memory device for controlling all gaming functions of the gaming device including symbol interactions (Col.

4:14:62, Col. 5:10-15). Hughs-Baird teaches all of the above limitations, but excludes a payout based on the transformed symbol and at least one other symbol other than the interacting symbol and the transformed symbol. Bennett discloses a slot machine game where a sprite (interactive symbol) swaps symbols (transforms the symbols) and if any winning combinations occur a payout is paid to the player (Col. 5:25-33). The winning combinations include the transformed symbol and at least one other symbol other than the interactive symbol and transformed symbol (Figs. 6a-c – Note: the swap symbols are on different pay-lines). Hughs-Baird discloses that gaming devices with a variety of symbols are well known (Col. 1:44-45). Hughs-Baird also discloses that providing a gaming device with a gaming scheme which provides award for obtaining symbols that interact is exciting, pleasurable, and enjoyable to players, considering that one spin or one touch can bring instant failure or success (Col. 7:30-35). Bennett discloses that gaming manufacturers are keen to devise games that are popular to improve sales. Bennett further discloses that providing complexity in numbering and combinations of indicia that could result in a win would convince a player that there is greater chance of winning and keeps their interest in the game (Col. 1:37-40; Col. 1:47-52). It would have been obvious to one of ordinary skill at the time of the invention to modify the interactive symbol gaming device, as taught by Hughs-Baird, with a payout based on all symbols (transformed and non-interacting/transformed symbols) on a particular pay-line, as taught by Bennett, to increase a player's interest and excitement and as a result sales will increase.

Claims 30 & 44: Hughs-Baird discloses displaying at least one interactive symbol arranged in at least one of the plurality of reels (Figs. 5a-d).

Claims 31 & 45: Bennett discloses displaying at least one interactive symbol not arranged in the plurality of reels (Figs. 6a-c).

Claims 36 & 50: Hughs-Baird discloses the gaming device has a program that automatically begins a secondary or bonus round when a player has achieved a qualifying condition or triggering event in the primary game (Col. 5:10-15).

Claims 37 & 51: It is notoriously well known in the art to have triggering events to a feature game that comprise of amount of wager, maximum wager, etc.

Claims 38-39 & 52-53: Hughs-Baird discloses that upon player selection of symbol (80) symbols (78), (82), and (80) interact/transform with each other. As a result, player is awarded a prize (Col. 7:55-65; Figs. 5a-d).

Claim 40: Bennett discloses that during play of the main game if a winning combination is formed the machine pays a prize. Upon a triggering event (random combination, which does not exclude the random winning combination as a trigger combination) a sprite transforms or swaps one or more symbols and any combinations formed with the symbols pays a prize according to the scorecard rules/paytable (Col. 3:56-60) of the main part of the game (Col. 1:60-65, Col. 2:7-10, Col. 5:25-33). Bennett discloses that the gaming invention can be applied to traditional poker style machines or draw poker machines (Col. 2:55-61). Figs. 6a-c discloses the game scenario invoking the interactive symbol. Originally the top row comprised of "four of a kind" combination (well known in the art), but after transformation the Jack became a King forming a "Five of a

kind". As such, a four of a kind result is a first winning combination and the five of a kind is a second winning combination. Accordingly poker pay tables are well known in the art to produce different payouts for different combinations.

Claim 54: Hughs-Baird discloses that the controller (processor and memory) includes program code for controlling the gaming device so that it plays a particular game in accordance with applicable game scheme and any applicable pay tables (includes pay award based on interacting and transforming symbols) (Col. 4:30-33).

Response to Arguments

Applicant's arguments filed 12/11/06 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Hughs-Baird discloses that gaming devices with a variety of symbols are well known (Col. 1:44-45). Hughs-Baird discloses that providing a gaming device with a gaming scheme which provides awards for obtaining symbols that interact is exciting, pleasurable, and enjoyable to players, considering that one spin or one touch can bring instant failure or success (Col. 7:30-35). Bennett discloses that gaming

manufacturers are keen to devise games that are popular to improve sales. Bennett further discloses that providing complexity in numbering and combinations of indicia that could result in a win would convince a player that there is greater chance of winning and keeps their interest in the game (Col. 1:37-40; Col. 1:47-52). Both references are drawn toward interacting symbols and transformed symbols. Hughs-Baird and Bennett show that complexity in winning combinations appeal to the player or increase player interest. It is well known in the art that the more interested a player is or the more chances/possibilities a player has to win a payout the more likely a player will play a gaming machine. As a result, the game provider's revenue increases. The concept to be taken from Bennett is a payout based on the transformed symbol and at least one other symbol other than the interacting symbol and the transformed symbol. To modify Hughs-Baird with such a payout opportunity would be well within the realm of one of ordinary skill at the time of the invention. Such a modification would provide the above advantages as disclosed by both references. Thus, motivation to combine is met.

In regards to Claim 40, please see above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The US Patent of Rothschild (6,786,818), Baerlocher (6,561,900), Rose (6,589,114), Kaminkow (6,731,313), the US PreGrant Pub.'s of Rogers (2003/0064802), and Visocnik (2004/0048646) all teach similar structured gaming devices with interactive symbols. The US PreGrant Publication of Gauselmann

(2004/0092299) discloses player selectable payouts. The US Patent of Acres (6,319,125) teaches triggering events based on wager related data.

This is a continuation of applicant's earlier Application No. 09/971993 (08/09/06). All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11/31/07

ROBERT OLSZEWSKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700